UNITED STATES PATENT and TRADEMARK OFFICE

PET DEC

UNDER SECRETARY OF COMMERCE FOR INTELLECTUAL PROPERTY AND
DIRECTOR OF THE UNITED STATES PATENT AND TRADEMARK OFFICE
WASHINGTON, D.C. 20231
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Mailed: JUN - 2 2004

In re application of :
Brigette Falconnier : DECISION ON
Serial No. 09/423,665 : PETITION
Filed: November 22, 1999 :
For: NOVEL CLEAR BEVERAGE OPTIONALLY ALCOHOLIC CONTAINING ANETHOL AND CLOUDY DILUTED BEVERAGE OBTAINED BY DILUTION

This is a decision on the PETITION UNDER 37 CFR 1.181 TO WITHDRAW THE FINALITY OF THE OFFICE ACTION mailed December 2, 2003.

On July 23, 2001, a final Office action was mailed to applicants. An after final amendment was submitted by Applicants on December 31, 2001. An advisory action was mailed January 17, 2002 advising Applicants that the reply would not be entered because it raised new issues requiring a new search and/or further consideration.

Applicants then filed a request for a Continued Prosecution Application on February 28, 2002. Along with the request was a request for the previously submitted amendment after final to be entered into the application and considered by the examiner.

On December 2, 2003 a final office action was mailed. The examiner stated in the office action that all claims were drawn to the same invention claimed in the earlier application and could have been finally rejected on the grounds and art of record in the next office action if they had been entered in the earlier application.

On April 2, 2004, the instant petition was filed. It is noted that the instant petition was submitted by Petitioner on April 2, 2004 which falls more than two months after the date of the final office action thereby making the instant petition untimely under Rule 181. Nonetheless, the instant petition will be considered on its merits. Petitioner has argued that the finality of the last Office action is improper.

DECISION

As set forth in the petition, the standard for making an Office action final is set forth in section 706.07(b) of the MPEP which states:

706.07(b) Final Rejection, When Proper on First Action

The claims of a new application may be finally rejected in the first Office action in those situations where (A) the new application is a continuing application of, or a substitute for, an earlier application, and (B) all claims of the new application (1) are drawn to the same invention claimed in the earlier application, and (2) would have been properly finally rejected on the grounds and art of record in the next Office action if they had been entered in the earlier application.

However, it would not be proper to make final a first Office action in a continuing or

substitute application where that application contains material which was presented in the earlier application after final rejection or closing of prosecution but was denied entry because (A) new issues were raised that required further consideration and/or search, or (B) the issue of new matter was raised.

As stated above, because the examiner refused entry of the amendment after final, it was clearly improper to make the office action of December 2, 2003 final.

Accordingly, the petition is **GRANTED**.

Petitioner also requests that the period for responding to the outstanding office action be restarted. Section (f) of Rule 181 states:

(f) The mere filing of a petition will not stay any period for reply that may be running against the application, nor act as a stay of other proceedings. Any petition under this part not filed within two months of the mailing date of the action or notice from which relief is requested may be dismissed as untimely, except as otherwise provided. This two-month period is not extendable.

It is noted that applicant's first request for a restarting of the period for response is in the instant petition, four months after the mailing of the final rejection. Even upon withdrawal of the finality of the December 2, 2003 office action, the grounds of rejection set forth in the office action would still apply and applicants would still have an obligation to respond in a timely manner. Because the rule clearly states that the filing of a petition will not stay any period for reply that may be running against the application, the request for restarting the period for response is denied. The period for response set forth in the December 2, 2003 office action still applies.

Jacqueline M. Stone, Director
Technology Center 1700
Chemical and Materials Engineering

JACOBSON HOLMAN PLLC
400 SEVENTH STREET N.W.
SUITE 600
WASHINGTON DC 20004